



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Louise C. Sengupta

Art Unit: 1731

Appl. No.: 10/687,506

Examiner: Carolos N. Lopez

Filed: 10/16/2003

Atty Docket: JSF01-0068D1/WJT08-0044D1

For: **ELECTRONICALLY
TUNABLE, LOW-LOSS CERAMIC
MATERIALS INCLUDING A
TUNABLE DIELECTRIC PHASE AND
MULTIPLE METAL OXIDE PHASES**

AFFIDAVIT UNDER RULE 1.132

STATE OF MARYLAND)
) SS
COUNTY OF HOWARD)

Louise C. Sengupta, being duly sworn, does hereby depose and say as follows:

That she is currently the first named inventor on the present above captioned application as well as a named inventor of the cited art U.S. Patent Nos. 6,404,614, 6,737,179 and 6,⁵¹⁴~~154~~,895.

She further states that the inventorship of the present application and aforementioned patents is correct and that any invention disclosed but not claimed in the aforementioned cited references was derived by Affiant. In particular the claimed invention of the present application, if disclosed in the cited art, was derived by Ms. Sengupta.

Further deponent sayeth not.


Louise C. Sengupta

REMARKS

These remarks are submitted in reply to the Office Action dated January 15, 2008. Applicant respectfully requests reconsideration and further examination of the patent application under 37 C.F.R. § 1.111.

Claims 1 – 3, 7 - 11, 24 and 25 remain in the application. Claims 4 - 6 were previously cancelled. Based on the remarks herein, Applicant respectfully requests that the Examiner reconsider and withdraw all outstanding rejections.

I. The declaration under 37 CFR 1.132 filed 10/30/07 was considered insufficient to overcome the rejection of claims 1-11 and 24-25 based upon 35 USC 102(e) as set forth in the last Office action. The Office Action stated that MPEP 2136.04 notes that: Therefore, when the unclaimed subject matter of a reference is applicant's own invention, applicant may overcome a prima facie case based on the patent, U.S. patent application publication, or international application publication, by showing that the disclosure is a description of applicant's own previous work. Such a showing can be made by proving that the patentee, or the inventor(s) of the U.S. patent application publication or the international application publication, was associated with applicant (e.g. worked for the same company) and learned of applicant's invention from applicant. In re Mathews, 408 F.2d 1393, 161 USPQ 276 (CCPA 1969).

The Office Action further stated that the affidavit does not show the relationship between the applicant of the application and the patentees of the applied references, nor shows that the patentees learned of applicant's invention from the applicant.

Applicant respectfully submits that the applicant of the present invention is also an applicant of the cited patent. Thus, the relationship between the inventors is that is the same person. The affidavit clearly articulates that:

... inventorship of the present application and aforementioned patents is correct and that any invention disclosed but not claimed in the aforementioned cited references was derived by Affiant. In particular the claimed invention of the present application, if disclosed in the cited art, was derived by Ms. Sengupta.

In addition to the fact that the affiant and inventor in the cited art are the same person, Applicant is submitting with the present response a recorded assignment of the present application to Paratek Microwave, Inc. It is noted that the cited art as verified by the recorded assignment at the Patent Office is also assigned to Paratek Microwave, Inc. Also, the affidavit clearly states that the claimed invention if disclosed in the cited art was derived (i.e., learned from) affiant. A copy of the affidavit submitted from the last response is attached hereto to ensure we are discussing the same affidavit.

Applicant placed telephone call to Examiner Lopez and left a message on Thursday, May 29, 2008, to discuss the aforementioned issues, however as Applicant has not received a return call to date, the present response is being submitted.

With the clarification of the affidavit, Applicant respectfully submits that all outstanding rejections have been addressed and all remaining rejections have been traversed.



Conclusion

From the foregoing, Applicants respectfully submit that all of the stated grounds of rejections have been properly traversed, accommodated, or rendered moot. Accordingly, Applicants respectfully request that the application is in condition for allowance and respectfully request such action.

If the Examiner believes, for any reasons, that personal communication will expedite prosecution of this application the Examiner is invited to telephone the undersigned at the following number: 202-607-4607.

The USPTO is authorized to charge Deposit Account No. 502697 any fees associated with this response.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "James S. Finn", written over a horizontal line.

James S. Finn
Reg. No. 38,450

C/O Bill Tucker
2631 Lakeforest Ct.
Dallas, TX 75214
202/607-4607



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

JULY 17, 2001

PTAS
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UNITED STATES PATENT AND TRADEMARK OFFICE
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 04/23/2001

REEL/FRAME: 011748/0143
NUMBER OF PAGES: 6

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:
SENGUPTA, LOUISE C.

DOC DATE: 03/01/2001

ASSIGNOR:
ZHANG, XUBAI

DOC DATE: 03/01/2001

ASSIGNOR:
CHIU, LUNA H.

DOC DATE: 03/01/2001

ASSIGNEE:
PARATEK MICROWAVE, INC.
6935 OAKLAND MILLS ROAD, SUITE N
COLUMBIA, MARYLAND 21045

SERIAL NUMBER: 09768690
PATENT NUMBER:

FILING DATE: 01/24/2001
ISSUE DATE:

ASSIGNMENT

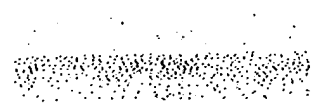
WHEREAS, WE, LOUISE C. SENGUPTA, residing at 12 New Haven Blvd., Warwick, Maryland 21912; XUBAI ZHANG, residing at 8751 Manahan Drive, Ellicott City, Maryland 21043; and, LUNA H. CHIU, residing at 3929 Bush Court, Abingdon, Maryland 21009; respectively, have invented certain improvements in: **ELECTRONICALLY TUNABLE, LOW-LOSS CERAMIC MATERIALS INCLUDING A TUNABLE DIELECTRIC PHASE AND MULTIPLE METAL OXIDE PHASES** for which we filed Application Serial No. 09/768,690 having a filing date of January 24, 2001; and

WHEREAS, PARATEK MICROWAVE, INC., a corporation organized and existing under the laws of the State of ^{Delaware} ~~Maryland~~; having its principal place of business at 6935 Oakland Mills Road, Suite N, Columbia, MD 21045, is desirous of acquiring an interest therein;



NOW, THEREFORE, in consideration of One (\$1.00) Dollar and other good and valuable consideration paid to us by said assignee, receipt whereof we hereby acknowledge, we do hereby assign, sell, transfer, and set over unto said assignee the entire right, title, and interest in and to said application and the inventions and improvements therein disclosed for the United States and all foreign countries and any Letters Patent which may issue therefor in the United States and all foreign countries and all divisions, reissues, continuations, renewals, and/or extensions thereof including all priority rights under the International Convention associated therewith for each country and the Union, said assignee to have and to hold the interests herein assigned to the full ends of the terms of said Letters Patent and any and all divisions, reissues, continuations, renewals, and/or extensions thereof, respectively, as fully and entirely as the same would have been held and enjoyed by us had this assignment not been made.

The Commissioner of Patents and Trademarks is requested to issue such Letters Patent in accordance herewith. We covenant that we are the lawful owners of the said application, inventions, and improvements, that the same are unencumbered, that no license has been granted to make, use, or vend the said



inventions or improvements or any of them, and that we have the full right to make this assignment.

And for the consideration aforesaid, we agree jointly and individually that we will communicate to said assignee or the representatives thereof any facts known to us respecting said inventions and improvements, and will, upon request, but without expense to us, testify in any legal proceedings, sign all lawful papers, execute all divisional, reissue, continuation, renewal, and/or extension applications, make all rightful oaths, and generally do all other and further lawful acts, deemed necessary or expedient by said assignee or by counsel for said assignee, to assist or enable said assignee to obtain and enforce full benefits from the rights and interests herein assigned. This assignment shall be binding upon our heirs, executors, administrators, and/or assigns, and shall inure to the benefit of the heirs, executors, administrators, successors, and/or assigns, as the case may be, of said assignee.


LOUISE C. SENGUPTA

3/1/01
Date


XUBAI ZHANG

3/1/01
Date


LUNA H. CHIU

3/1/01
Date

State of Maryland:

: ss.

County of Howard:

Before me, a Notary Public in and for the said County and State, personally appeared **LOUISE C. SENGUPTA, XUBAI ZHANG and LUNA H. CHIU** who acknowledged that they are the persons who executed the foregoing assignment and acknowledged it to be their free and voluntary act and deed.

Witness my hand and notarial seal this 1st day of March, 2001.

Deborah Cowling
Notary Public

(NOTARIAL SEAL)